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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,545	11/07/2005	Larry Salvadori	20518/51 (S-8500)	9818

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Tyco Healthcare Gap LP
IP Legal Dept.
15 Hampshire st.
Mansfield, MA 02048

EXAMINER

CAMPBELL, VICTORIA P

ART UNIT	PAPER NUMBER
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3763

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/536,545	Applicant(s) SALVADORI ET AL.	
	Examiner VICTORIA P. CAMPBELL	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

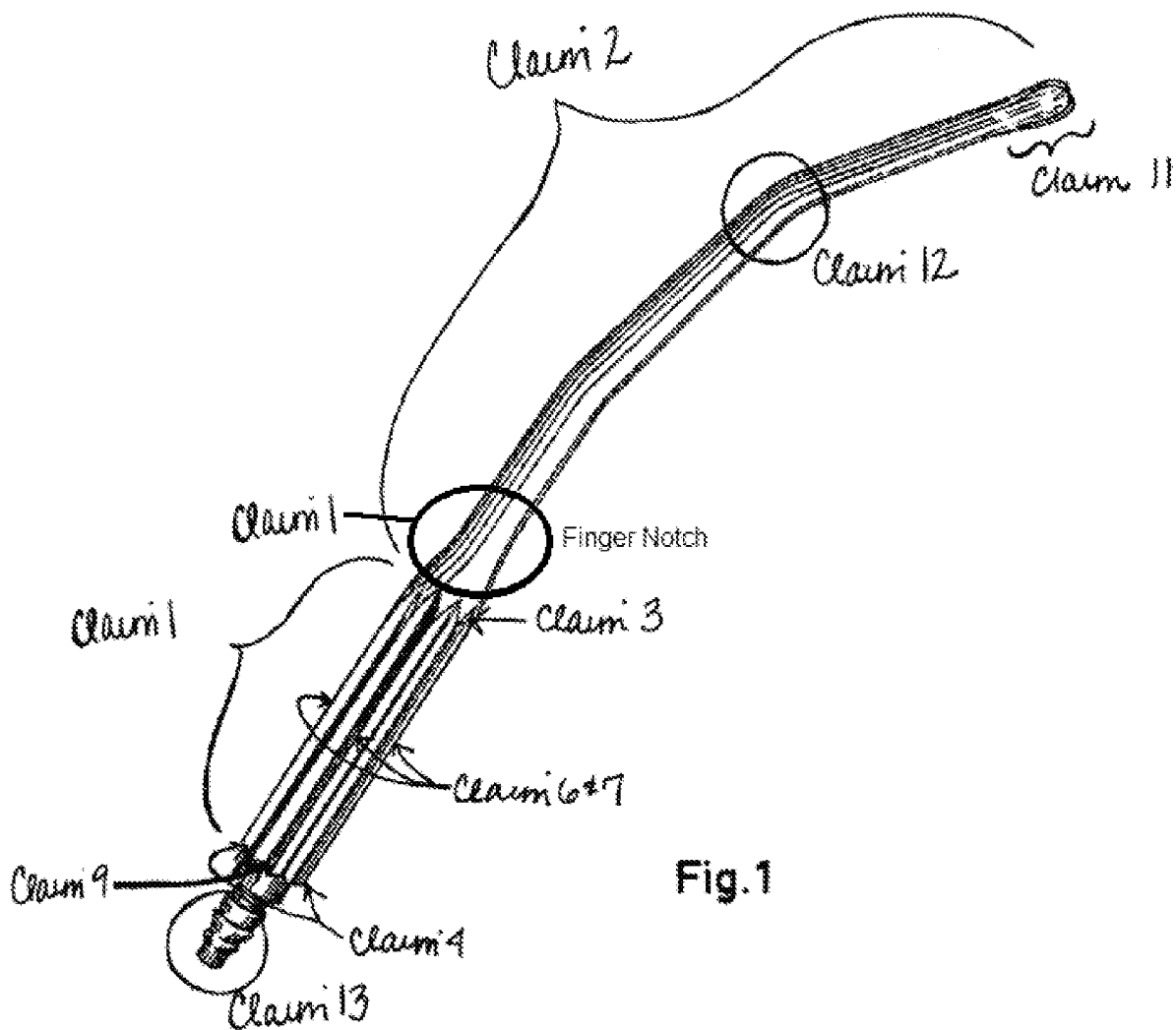
2. Claims 1-4, 6, 7, 9, 11-14, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN D264,246 to Ekbladh et al. Regarding the above claims, Ekbladh et al teach the following (drawing attached for clarity):

Regarding the instant claims, Ekbladh et al teach the following:

1. A surgical instrument comprising: a handle defining a longitudinal axis, the handle having an outer surface including a plurality of longitudinal fins that define a plurality of longitudinal grooves therebetween, and said handle having at least one finger notch.
2. The surgical instrument of claim 1, further comprising an elongated tubular portion having an opening configured for suction.
3. A surgical instrument as recited in claim 1, wherein at least one of the fins project radially from the outer surface.
4. A surgical instrument as recited in claim 1, wherein a pair of the fins project radially from the outer surface and are diametrically opposed.
6. A surgical instrument as recited in claim 1, wherein two separate pairs of the fins project radially from the outer surface and are diametrically disposed.

- 7.** A surgical instrument as recited in claim 6, wherein the two separate pairs are offset 90° relative to the longitudinal axis.
- 9.** A surgical instrument as recited in claim 1, wherein the grooves include guide channels that direct fluid to a proximal end of the handle.
- 11.** A surgical instrument as recited in claim 2, wherein the tubular portion includes a passageway that extends to the opening having a nozzle.
- 12.** A surgical instrument as recited in claim 2, wherein the tubular portion has a curvature adjacent a distal portion thereof.
- 13.** A surgical instrument as recited in claim 2, wherein a proximal end of the handle has an attachment configured to communicate with a suction source.
- 14.** A surgical instrument as recited in claim 1, wherein the surgical instrument has a center of mass located distal to the handle.
- 21.** A surgical instrument as recited in claim 1, wherein the at least one finger notch is a depression that receives a thumb and forefinger of a practitioner (depression of the surface can be seen in the attached figure).

Regarding claim 14, the surgical tool depicted has a handle shorter than its elongated extension. Both portions have similar diameters, therefore the mass of the elongated extension will pull the center of mass distal of the handle.



3. Claims 1, 5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,210,371 granted April 3, 2001 to Shaw. With regard to the above claims, Shaw teaches the following

Claim 1: A surgical instrument comprising a handle (Fig. 1, #12) defining a longitudinal axis (not labeled, but defined as the long axis through the center of handle #12), the handle having an outer surface (not labeled) including a plurality

of longitudinal fins (Fig. 1, #30 and #60) that define a plurality of longitudinal grooves therebetween (not labeled, but seen in Fig. 2 as the longitudinal space between fins #30 and fins #60), and said handle having at least one finger notch (Fig. 1, examiner interprets the area labeled by #20, between fins #30 and #60, to be a finger notch).

Claim 5: A surgical instrument as recited in claim 1, wherein a pair of the fins are opposed and disposed in a plane tangential to the outer surface of the handle (Fig. 3, #30).

Claim 8: A surgical instrument as recited in claim 1, wherein two separate pairs of the fins are opposed and disposed in alternate planes tangential to the outer surface of the handle (Fig. 3, #30 and #60; examiner notes that although fins #60 do not attach tangential to the outer surface, they do extend tangentially from the outer surface of the device).

4. Claims 1 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,779,654 issued July 14, 1998 to Foley et al. With regard to the above claims, Foley et al teach

Claim 1: A surgical instrument comprising a handle (Fig. 1, #12) defining a longitudinal axis (not labeled, but defined as the long axis through the center of handle #12), the handle having an outer surface (not labeled) including a plurality of longitudinal fins (Fig. 1, #14) that define a plurality of longitudinal grooves therebetween (not labeled), and said handle having at least one finger notch

(defined by the examiner at the position between the longitudinal fins, #14 and the bend in the neck of the handle near button #24).

Claim 18: A surgical instrument as recited in claim 1, wherein the fins are configured to facilitate gripping (Col. 2, lines 41-42).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ekbladh et al. Ekbladh et al teach the invention as disclosed above, including disposition of both a single pair and two pairs of fins radially with respect to the outer surface. Ekbladh et al fail to teach both a single pair and two pairs of opposed fins

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disposed tangentially in relation to the outer surface of the handle. However, the disposition of the fins in a plane or planes tangential to the handle as opposed to radial disposition as shown in Ekbladh et al would have been obvious to one of ordinary skill in the art at the time of the applicant's invention because such is an obvious matter of design choice wherein no stated problems are being solved and no unexpected results are obtained over the prior art.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ekbladh et al. Ekbladh et al teach the invention as discussed above, including grooves of identical volume. Ekbladh et al fail to teach grooves of differing volumes as defined by longitudinal fins disposed along the handle. However, it would have been obvious to one having ordinary skill in the art at the time of the applicant's invention to include grooves having differing volumes, occurring when fins are not equally spaced, as opposed to the grooves of identical volume as shown in Ekbladh et al, because such is an obvious matter of design choice wherein no stated problems are being solved and no unexpected results are obtained over the prior art.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ekbladh et al in view of US Patent No. 6,029,549 to Baker. Ekbladh et al teach all of the limitations of claim 1 as set forth above, but they do not teach or disclose a first wall thickness that smoothly increases to a second wall thickness, which defines a proximal to distal slope, nor do they teach or disclose a handle with a slope configuration defining a distal to proximal flow.

However, Baker teaches

A handle has a first wall thickness that smoothly increases to a second wall thickness (Col. 3, lines 48-56; the reference describes an inward tapering of the sides of the grooves [bit races] in addition to an arcuate wedge to decrease the volume of the space; see also Fig. 4 and Fig. 5).

Both the patent of Ekbladh et al and the patent of Baker pertain to the handle art, making them analogous. Modifying the handle of the surgical tool described by Ekbladh et al with the handle of the tool defined by Baker does not modify the function of the surgical tool. The physician is able to maintain his or her grip on the device with both tools, and thus substituting the handle of Baker onto the surgical tool of Ekbladh et al yields the predictable result of maintaining assured grip on the instrument during a procedure.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ekbladh et al in view of Shaw and Baker.

Regarding claim 20, Ekbladh teaches an elongated tubular portion with a passageway extending to an opening having a nozzle configured for suction, a handle mounted with the tubular portion and defining a longitudinal axis, the handle having an outer surface including a plurality of longitudinal fins, wherein the plurality of longitudinal fins include a first and second pair of the fins that project radially from the outer surface, the fins of each pair being diametrically opposed, the first and second pairs being offset 90 degrees relative to the longitudinal axis of the handle, and a finger notch. However, Ekbladh et al fail to teach a plurality of longitudinal fins opposed and disposed in alternate planes tangential to the outer surface of the handle, as well as a plurality of

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longitudinal grooves that include guide channels to direct fluid to the proximal end of the handle. Shaw teaches a plurality of longitudinal fins that are opposed and disposed in the alternate planes tangential to the outer surface of the handle, and Baker teaches that the plurality of longitudinal fins define a plurality of longitudinal grooves that include guide channels to direct fluid to a proximal end of the handle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of a surgical tool having a plurality of fins, oriented in a multitude of ways, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

10. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ekbladh et al in view of USPN 6,086,587 to Hawk.

Regarding claim 22, Ekbladh et al disclose the invention of claim 1 as described above, but fail to explicitly disclose a vent hold with may be open, partially covered, or completely covered.

Regarding claims 22 and 23, Hawk discloses

22. [...] wherein the at least one finger notch comprises a vent hole therein (Fig. 5, #53).

23. A surgical instrument as recited in claim 22, wherein the vent hole is open, partially covered, or completely covered (Col. 5, lines 54-64).

Ekbladh et al and Hawk are analogous art because they are from the same field of endeavor/problem solving area of suction apparatus. At the time of the invention, it

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would have been obvious to one of ordinary skill in the art, having the teachings of Ekbladh et al and Hawk before him or her to modify the handle of Ekbladh et al to include the vent hole of Hawk because it allows the physician to control the degree of suction (Hawk, Col. 5, lines 54-57). Therefore, it would have been obvious to combine Ekbladh et al with Hawk to obtain the invention in the instant claims.

Response to Amendment

11. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

12. In light of the new drawings submitted by applicant, the Examiner withdraws any objections to the drawings.

13. In light of the amendments made to the specification, the Examiner withdraws any objections to the specification.

14. In light of the amendments to claims 9 and 20, the rejection under 35 USC § 112, first paragraph, is withdrawn.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA P. CAMPBELL whose telephone number is (571) 270-5035. The examiner can normally be reached on Monday-Thursday, 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victoria P. Campbell
Examiner, AU 3763

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art Unit 3763